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Aktenzeichen / Case Number / N^o du recours : T 114/89 - 3.4.1

Anmeldenummer / Filing No / N^o de la demande : 81 902 796.2

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 64 506

Bezeichnung der Erfindung: Improvements in or relating to methods of producing
Title of invention: devices comprising metallised regions on dielectric
Titre de l'invention : substrates

Klassifikation / Classification / Classement : H01L 41/22

ENTSCHEIDUNG / DECISION

vom / of / du 9 April 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

National Research Development Corporation

Einsprechender / Opponent / Opposant :

N.V. Philips Gloeilampenfabriken

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Article 102(4) and (5), 122; Rule 58

Schlagwort / Keyword / Mot clé :

"Patent maintained in amended form" - "Non-compliance with time limit under Rule 58(5) EPC" - "Patent automatically revoked" - "Non-existent appeal" - "Application under Article 122 EPC remitted" - "Effect of amended Rule 58 EPC to be decided by first instance"

Leitsatz / Headnote / Sommaire



Case Number : T 114/89 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 9 April 1990

Appellant : National Research Development Corporation
(Proprietor of the patent) 101 Newington Causeway
London SE1 6BU

Representative : Beckham, R.W.
Ministry of Defence Patents
Room 2012
Empress State Building
Lillie Road
London DW16 1TR

Respondent : N.V. Philips Gloeilampenfabriken
(Opponent) Groenewoudseweg 1
NL-5621 BA Eindhoven

Representative : Veenska Gustaaf
International Octrooibureau B.V.
Prof. Holstlaan 6
NL-5656 AA Eindhoven

Decision under appeal : Decision of Opposition Division of the European
Patent Office dated 30 January 1989 revoking
European patent No. 0 064 506 pursuant to
Article 102(4) & (5) EPC.

Composition of the Board :

Chairman : K. Lederer
Members : S.G.D. Paterson
H.J. Reich

Summary of Facts and Submissions

- I. A Notice of Opposition to European patent No. 64 506 was filed. In due course, following oral proceedings, the Opposition Division issued a communication under Rule 58(4) EPC, stating its intention to maintain the patent in amended form, and since no disapproval of the text was expressed, a communication dated 24 August 1988 under Rule 58(5) EPC was issued, in which the patent proprietor was requested to pay the printing fee and to file translations of the amended claims within three months from notification, i.e. by 3 December 1988. The printing fee was not paid and the translations were not filed until 9 December 1988. Following a communication as to these omissions, a document dated 30 January 1989 was issued by the Formalities Officer of the Opposition Division, headed "Revocation of the European patent pursuant to Article 102(4) and (5) EPC", stating that "The European patent therefore has to be revoked". This document went on to state that "This decision is open to appeal (Article 106(1) EPC)", and gave details as to how to appeal.

- II. The Patentee filed a Notice of Appeal against the decision to revoke the patent, and paid the appeal fee. The letter stated that "Due to a delay in the provision of translations problem, the applicant was unfortunately late in the payment of the printing fee together with the filing of the translations following opposition proceedings".

- III. In a communication on behalf of the Board of Appeal, reference was made to Decisions T 26/88 dated 7 July 1989 (to be published) and T 522/88 dated 19 December 1989, and it was provisionally stated that the Board considered the

document dated 30 January 1989 to be in substance a communication under Rule 69(1) EPC, and that the Board's provisional intention was to consider the appeal as non-existent.

- IV. In his reply the Appellant (Patentee) filed an application for re-establishment under Article 122 EPC, and he also requested consideration "as to whether the revised procedure under Rule 58 EPC can be applied to this case". Furthermore the Patentee contested the interpretation of Article 102(4) and (5) EPC set out in Decisions T 26/88 and T 522/88, and submitted that "a decision is required under Article 102(4) and (5) EPC, but that decision is mandatory". It was queried as to how an error in handling papers within the EPO would be dealt with, if no appeal was available in such circumstances.

The following possibilities were put forward for consideration by the Board:

- (a) treating the appeal filed 10 February 1989 on this letter as an application under the new Rule 58 for the grant and printing fee to be paid late with a surcharge; this is possible in view of the date of operation of new Rule 58; a formal request for continuing the processing;
- (b) the application for restoration under Article 122 EPC in view of the revocation of the patent under Article 102;
- (c) an appeal against either decision under (a) or (b) above under Rule 69(1) or the original decision under Article 102 EPC.

The Respondent (Opponent) has not replied to the Board's communication within the stated time limit.

Reasons for the Decision

1. For the reasons set out in Decision T 26/88 (to be published), in the Board's judgment, according to the proper interpretation of Article 102(4) and (5) EPC, a patent becomes immediately and automatically revoked upon expiry of the relevant three-month time limit if the required fee is not paid and if the required translation is not filed within such time limit. Such immediate automatic revocation upon expiry of the relevant time limit is mandatory under Article 102(4) and (5) EPC (as was in fact accepted by the Appellant - see paragraph IV above). No decision of revocation is therefore necessary in order that revocation should occur, nor is such a decision of revocation appropriate, since there is nothing to be decided.
2. In relation to the Patentee's submission that a decision is required, and that the situation under Article 102 EPC is analogous to criminal proceedings in which a mandatory sentence follows a finding of guilt, reference is made to paragraph 3.8 of Decision T 26/88, which explains the procedure under Rule 69(2) EPC in the event that a patentee wishes to challenge a finding of fact which has been set out in a communication under Rule 69(1) EPC.
3. In the present case, it is accepted by the Patentee that no printing fee was paid and no translation was filed before expiry of the relevant time limit on 3 December 1988. Thus the patent was automatically revoked on 4 December 1988. In view of the mandatory nature of such

revocation as stated above, there is nothing left to be decided, either by the Opposition Division or by way of appeal.

4. Accordingly, for the reasons set out in Decision T 26/88, in the Board's view the document which was issued by the Formalities Officer of the Opposition Division on 30 January 1989 should be interpreted as a communication under Rule 69(1) EPC of the revocation of the patent which had already occurred on 4 December 1988. On this basis, there has been no decision within Article 106(1) EPC, and the appeal should therefore be regarded as not having existed. The appeal fee should consequently be refunded.
5. As to the Patentee's submissions concerning the new Rule 58 EPC and his application under Article 122 EPC and following paragraphs 12 and 13 of Decision T 26/88, in the Board's view these matters should be decided by the first instance.

Order

For these reasons, it is decided that:

1. The appeal fee shall be refunded.
2. The case is remitted to the Opposition Division in order that the following matters should be decided:
 - (a) Whether the amended Rule 58 EPC set out in the Decision of the Administrative Council which entered into force on 1 April 1989 is applicable to the present case.

(b) The application for re-establishment under
Article 122 EPC filed on 5 February 1990.

The Registrar:

The Chairman:

M. Beer

K. Lederer